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EXAMINER	
POLTORAK, PIOTR	
ART UNIT	**PAPER NUMBER**
2134	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/045,453	MARKEL, STEVEN O.	
	Examiner	Art Unit	
	Peter Poltorak	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 January 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11 and 13-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11 and 13-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claim 1-11 and 13-17 drawn to a method and a system that utilize set of rules defining authoring options, classified in class 726, subclass 1.

II. Claim 12, recites specific rules for a display platform for, e.g. a set of fonts, classified in class 345, subclass 418.

The inventions are distinct, each from the other because of the following reasons:

Inventions "a set of rules for a display platform" and "a method and a system of media enhancement" are combination with subcombination. The combination with subcombination are distinct from each other if they are shown that subcombination not essential to combination disclosed as usable together in a single combination.

In the instant case, invention (I) to a method and a system that utilize set of rules in defining authoring options can utilize different set of rules than the rules recited in claim 12, (II) has separate utility such the set of rules as recited in claim 12 does not have to be employed in defining authoring options. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I a method and a system that utilize set of rules defining

authoring options is not required for Group II specific rules for a display platform, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

1. A telephone call was made to Scott Doyle (703-760-7721) on 7/20/05 to request an oral election to the above restriction requirement. Scott Doyle elected Group I (claims 1-11 and 12-17) and James Denaro followed (on behalf of Scott Doyle) the oral election with the phone call advising that the Group I has been elected without traverse.
2. Applicant is advised that a reply to this Office Action should include cancellation of nonelected claims or other appropriate action.

3. Claims 1-11 and 13-17 have been examined.
4. Claim 12 has been withdrawn.

Priority

5. Acknowledgment is made of applicant's claim for priority based on a U.S. provisional patent application number 60/244947 filed on November 1, 2000.

Claim Objections

6. Applicant should address the spelling error in first line of claim 15, wherein "though" should be spelled "through" or preferably to change the term "through" to the term "by".

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-11 and 13-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.
8. Claim 1 recites steps for creating a media enhancement file; however, the claim language does not offer the clear understanding of the claimed invention.
9. Specifically, the specification does not provide the definition of "constraint". Additionally it is not clear what constitutes "authoring options" or an "authoring action" and how the options are defined. Furthermore it is not understood what "post processing program" is and what "post processing rules" do.
10. The examiner did not find clear definition of "platform rules". Claim 1 recites "a set of rules", claim 2 "a post processing set of rules" and claim 5 "a set of platform rules", and it is not clear from the specification the differences between these rules. A similar problem is observed throughout claims 1-11, 13-17.
11. Other undefined terms are as follows: "presentation platform".

12. It is unclear, whether a step is missing in claims 1 and 15 (a media enhancement file is saved without first being created) or whether the previous steps constitute creating a file wherein the limitation (of creating a file) has not been specified.
13. Claim 1 is directed towards a method. The preamble of claim 2 is directed towards the method of claim 1 but the substance is drawn to a product. It is not clear how claim 2 further limits the method of claim 1.
14. Claim 5 further refines claim 1 by introducing an additional step. However, it is not clear whether the order of the steps is important and if so at what point "creating a set of platform rules" should occur.
15. A similar problem is noticed in claim 6 wherein the order of the steps is unclear.
16. Claims 8, 14 and 17 recites: "a step associated with said rule". It is not clear what constitutes of association or how the rule is associated. Furthermore, it is unclear what the step is.
17. The phrase: "a step of performing a step" in claims 9-11 is not understood. Applicant is encouraged to find better language to describe the method.
18. It is unclear in claims 1 and 13 what the subject is that produces an image. Is it the constraint or the platforms? Furthermore it is unclear if the constraint is in the platform or in the rules set.
19. Claim 15 is drawn to a product by process. Claims 16 and 17 are also drawn to a product that are modified by process and are written as method claims (... file ... further comprising the step of ...").

20. The examiner suggests altering the claim language so that claims 16 and 17 are consistent with the product by method structure: e.g. deleting "comprising" and insert "created by" in the claims preamble.

21. As suggested above the claim language presents multiple terms that are not clear. For purposes of further examination these phrases are treated as best understood.

Appropriate correction is required.

Claim Rejections - 35 USC § 102 or 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

22. Claims 1-2 and 7-8, 13-17 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over *Convington et al. (U.S. Patent No. 5524193)*.

23. *Convington et al.* teach a program that allows authors to quickly and easily create a sequence of media events such as a video clip *(Abstract)*. *Convington et al.* teach

configuration buttons 840a to 840e that allow the user to customize the playback of the video event being created. In the embodiment shown in FIG. 8, clicking on the arrow displayed at the right side of any of configuration buttons 840a to 840b causes a pulldown menu to be displayed listing the selections that are available for that particular configuration button *(col. 13 lines 37-43).*

This reads on: establishing a set of rules describing at least one constraint for a television platforms that produce an image showing a television picture and enhancements and defining authoring options in a media enhancement authoring program using the set of rules.

24. *Convington et al.* teach that the options available for "Speed" configuration button 840c in the embodiment shown in FIG. 8 include "Normal", "Fast", "Faster", "Fastest", "Slow", "Slower", and "Slowest". This configuration button allows the user to specify the speed at which the video segment will be played back when the video event is activated *(col.3 lines 54-60).*

This reads on: employing said authoring program to perform an authoring action.

25. File buttons 855a to 855c allow the video event to be stored as an object in the non-volatile memory of the computer at any time during the creation process. The "Save" button 855a provides for saving the configuration of the event at the time the "Save" button 855a is clicked on under the file name currently specified for the event. If no file name has been specified, a dialog box appears prompting the user to enter a file name so the object for the event can be saved *(col. 4 lines 18-25).*

This reads on: saving the media enhancement file.

26. *Convington et al.* do not explicitly teach that the constraints are for at least two television platforms.

However, *Convington et al.* is relevant to various environment a *(Background of the invention, col. 1 lines 15-col 2 line 35)*, which leads the examiner to believe that *Convington et al.'s* invention as taught is available for more than one television platform *(e.g. PC, MAC or IE, Netscape etc.)*. Even if *Convington et al.'s* invention were directed only to one television platform it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement such a modification. One of ordinary skill in the art would have been motivated to perform such a modification in order for a user to be able to create multimedia material for various television platforms.

27. Claims 5-6 and 9-11 are rejected under 35 U.S.C. 103(a) as unpatentable over *Convington et al. (U.S. Patent No. 5524193)* in view of *Official Notice.*

28. As per claims 5-6 *Convington et al.* teach rules as discussed above.

Convington et al. do not explicitly teach that the created rules are downloaded to a display platform.

Official Notice is taken that it is old and well-known practice to download rules *(e.g. Sposato et al., col. 14 line 64-col. 15 line 4)*. One of ordinary skill in the art at the time of applicant's invention would have been motivated to allow downloading in order to allow additional ways to access/receive/updates rules.

29. As per claims 9-11 *Convington et al.* teach graphic elements *(e.g. Abstract and Fig. 1)*.

Convington et al. but does not explicitly teach different formats and colors available for the element selection.

30. Official Notice is taken that it is old and well-known practice to provide different sizes, colors and/or formats for graphic element selection *(e.g. Microsoft Word)*. One of ordinary skill in the art at the time of applicant's invention would have been motivated to provide a different colors for sizes, colors and/or formats for graphic element selection in order to articulate and make more interesting the multimedia material.

    Providing multiple varieties of sizes, colors and/or formats results in checking users' selection.

31. Claims 3-4 are rejected under 35 U.S.C. 103(a) as unpatentable over *Convington et al. (U.S. Patent No. 5524193)* in view of *MacPhail (U.S. Patent No. 6593943).*

32. *Convington et al.* teach set of rules as discussed above.

    Convington et al. do not teach that the set of rules comprising an XML compliant file.

33. *MacPhail* teaches a set of rules comprising an XML compliant file *(col. 8 lines 43-49 and col. 6 line 58-col. 7 line 9).*

    It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize a set of rules comprising an XML compliant file as taught by *MacPhail.* One of ordinary skill in the art would have been motivated to perform such a modification in order to have a set of rule suitable for data transmission.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571)272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Signature

04/21/05

Date

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